

Notice of Allowability

Application No.

09/054,565

Examiner

Charles Goodman

Applicant(s)

SIMPSON, JACK RICHARD

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to the amendment filed after CAFC decision filed on 2/23/06.
2. ☒ The allowed claim(s) is/are 1-10, 14 and 30.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413), Paper No./Mail Date _____
7. ☐ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____.


CHARLES GOODMAN
PRIMARY EXAMINER

REASONS FOR ALLOWANCE

1. The following is an examiner's statement of reasons for allowance:

The prior art of record do not anticipate nor do they reasonably suggest the rotary cutting die and method as claimed in claims 1, 8 and 30. The closest prior art, Rilitz et al (US 5,161,442), teaches an apparatus for cross cutting running webs comprising, inter alia, a base (7, 9); at least one "scrap" cutting blade (8, 11); and at least one scrap stripper (13, 14). Note Figs. 1-2. For a more thorough review of the claimed limitations, please refer to the decision by the U.S. Court of Appeals for the Federal Circuit submitted on August 2, 2004 (In re Jack Richard Simpson). The salient point from the decision upholds the USPTO's position that the blade of Rilitz et al meet or read on the claimed "at least one scrap cutting blade" due to the fact that Rilitz et al's blade cuts both the product as well as scrap, and the stripper (or guide) of Rilitz et al also meets or reads on the claimed "at least one scrap stripper" since it acts on both the product and scrap, i.e. the scrap cutting and stripping functions are inherent in Rilitz et al's invention. Based upon said decision, the rejection of claims 27 and 29 on appeal was reversed. The current amended claim 1 includes the limitations of claim 27 and the new claim 30 is an independent form of previously presented claims 1 and 29.

With respect to the invention of claim 1, Rilitz et al's stripper (e.g. 13) includes both a base and finger (note Fig. 2), since these parts of the stripper are integral with each other as denoted by the cross-hatching. Moreover, the stripper is constructed of a resilient and compressible material. See e.g. c. 4, ll. 28-49, especially ll. 30-31. However, due to the design of Rilitz et al's stripper wherein the finger portion is curved and relatively far apart from the base portion (Fig. 2), it cannot be said that both the

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finger and base are compressed when the stripper is in the claimed retracted position. Moreover, none of the other prior art of record fairly teach or suggest this lacking feature.

With respect to the invention of claim 8, the claim 8 invention is directed to a method of cutting corrugated board. In contrast, Rilitz et al is directed to transporting and cutting a running web of paper or other relatively thin flexible sheet material. Note e.g. c. 1, ll. 7-13. Since corrugated board is not a relatively thin flexible sheet material, there is no teaching or suggestion in Rilitz et al to apply the teachings therein to corrugated board in a method of processing the same.

With respect to the invention of claim 30, Rilitz et al lacks the finger assuming a straight configuration when in the extended position. Note that the finger portion thereof is curved counter to the direction of movement of the knife (8) along its endless path. See e.g. c. 4, ll. 28-49. Due to this teaching, there is no suggestion to modify the finger of Rilitz et al et al to have the straight configuration as claimed.

For the above reasons, it is believed that the claimed inventions with the respective lacking features or steps in combination with all the other recited features and steps are allowable over the prior art of record.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."


2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Goodman whose telephone number is (571) 272-


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4508. The examiner can normally be reached on Monday-Friday between 8:30 AM to 6:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer Ashley, can be reached on (571) 272-4502. In lieu of mailing, it is encouraged that all formal responses be faxed to **(571) 273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

cg 
June 14, 2006


Charles Goodman
Primary Examiner
AU 3724

CHARLES GOODMAN
PRIMARY EXAMINER